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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/663,709 | 09/18/2000 | Hiroyuki Fujita | 001200 | 4404 |

7590

10/24/2002

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EXAMINER

GUPTA, ANISH

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 10/24/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/663,709

Applicant(s)

FUJITA, HIROYUKI

Examiner

Anish Gupta

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-10.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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Continuation of 2. NOTE: The amended claims place the limitation "A food" which would have to be addressed in the grounds for rejection. This would qualify as a new grounds for rejection.

Continuation of 3. Applicant's reply has overcome the following rejection(s): 112 Second Paragraph rejection over claim 1 with regards to % content.

Continuation of 5. does NOT place the application in condition for allowance because: of the following reasons.
For all of the rejections, Applicants argue that the reference applied do not teach peptide obtained by hydrolyzing the dried bonito with the claimed enzyme.

Applicant's arguments filed 10-15-02 have been fully considered but they are not persuasive.

All of the reference applied teach disclosed the claimed peptides. Although the reference of Masayasu et al. and Yoshikawa et al. do not teach the method of obtaining the peptide, the claims are still anticipated by the references because the MPEP states that "[t]he patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from the product of the prior art, the claims is unpatentable even though the prior product was made by a different process." MPEP 2113. Here the products are the same. For Yokoyama et al. the reference discloses the same peptides and the same source. Thus the characteristics described would necessarily be the same.
The rejections are maintained.

The rejection under 112 Second Paragraph is maintained because the Applicants did not provide what part of the fish meat would be a residue.

Finally, Applicants stated that the "Examiner has not specified whether 'Masayasu' refers to Japanese Unexamined Patent Publication 04069398 or to JP04-139196." To this, Applicants should note that the reference cited on 892, sent 11-20-01 listed JP04069398 as the reference relied upon. Thus, this is the reference cited in the rejection.